

PROPOSED AMENDMENT

Amendments to the Drawings

Please add new Figure 1D. The figure is a magnified view of the distal end of the embodiment of Fig. 1A. As such, Applicants believe that no new matter is introduced.

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CENTRAL FAX CENTER****APR 28 2010****Remarks/Arguments**

Applicants have received and carefully reviewed the Office Action of the Examiner mailed October 28, 2009. Currently, claims 49-53, 55-58, 64 and 65 remain pending. Claims 49-53, 55-58, 64 and 65 have been rejected. With this paper, claims 52, 53, 64, and 65 are canceled. Claims 49-51, 57, and 58 have been amended to clarify the relationships among the elements. A new drawing, Fig 1D, accompanied by the necessary amendments to the specification, has been presented to clarify certain features of the embodiment depicted in Fig. 1A. The relevant portion of Figure 1A is believed to be too small to introduce the necessary reference numerals. No new matter is introduced. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 112

Claims 49-53, 55-58, 64, and 65 were rejected under 35 U.S.C. 112, first paragraph, as failing to meet the written description requirement. Applicant has amended claims 49-51, 57, and 58 to further prosecution of this case. As such, this rejection is considered moot.

Claim Rejections – 35 USC § 102

Claims 49-53, 55-58, 64, and 65 were rejected under 35 U.S.C. 102(b) as anticipated by Dubrul et al. (U.S. Published Patent Application No. 2002/0019597), hereinafter Dubrul. After careful review, Applicant must respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131). Nowhere does Dubrul appear to teach or suggest, "a vacuum source fluidly attached to the proximal end of the catheter to provide a source of vacuum to the catheter lumen", as recited in claim 49.

The Office Action asserts that "there must be a vacuum source located outside the tissue and fluidly connected to the distal end of the first shaft and the second shaft". (Emphasis added.) Applicants must respectfully disagree. The source of vacuum found

PROPOSED AMENDMENT

in Dubrul is not specified. It may, for example, be provided within the distal portion of tubular body 121 by a plunger similar to that found in a common syringe. The plunger may have a seal to accommodate wires 128 if desired.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Roberson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Further, Dubrul does not appear to disclose a wire having a distal region including a distal tip having the properties recited in claim 49. Accordingly, Dubrul does not appear to anticipate *each and every element as set forth in the claim* and Applicants respectfully request that the rejection be withdrawn.

Additionally, for similar reasons as well as others, claims 50, 51, 55, 57, and 58, which depend from claim 49, and include significant additional limitations, are believed to be not anticipated by Dubrul and Applicants respectfully request that the rejections be withdrawn.

In the Response to Arguments, the Office Action discusses various features of the earlier presented claims which are no longer present in the amended claims. The related features of the amended claims are fully supported in the original Fig. 1a. The specification and claims have been amended to conform to the embodiment depicted.

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

PROPOSED AMENDMENT

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date: _____

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